

Appln No. 10/774,617
Amdt date August 14, 2006
Reply to Office action of March 13, 2006

application, Avery Dennison Corporation. In fact, at the time of the present invention, the subject matter of the Holguin et al. reference and the presently claimed invention were commonly owned by Avery Dennison, or subject to an obligation of assignment to Avery Dennison. Therefore, as a matter of law, Holguin et al. reference is *not citable* against the present application.

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

35 U.S.C. § 103(c)(1).

Attached hereto as Exhibit A is a copy of the Notice of Recordation of Assignment document for the present application. Attached as Exhibit B is a "Patent Assignment Abstract of Title" for the Holguin et al. reference, downloaded from the USPTO's website. These documents establish that the present application and the Holguin et al. reference have been assigned to Avery Dennison Corporation. In fact, the undersigned attorney is informed and believes that all of the inventors named in the Holguin et al. reference -- Daniel L. Holguin, H. Paul Barker, Ivan S.P. Lee, and Kenneth S. Lin -- as well as Sou Phong ("Ivan") Lee, the sole inventor on the present application, are, or at all relevant times were, employees of Avery Dennison Corporation, with obligations to assign their inventions to the Company. If necessary, a declaration to this effect can be presented.

Accordingly, the rejection of various claims over Vanhoye et al. in view of Holguin et al., as well as the rejection of other claims over Vanhoye et al. in view of Holguin et al and the '172 patent, should be withdrawn.

Application also submits that the '172 patent is non-analogous art, as it is neither in the same field of invention as the presently claimed subject matter nor directed to solving the same

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problem to which the presently claimed subject matter is addressed. As indicated in the "Field of the Invention," at page 1, the present application "pertains to pressure-sensitive adhesives, particularly emulsion-based acrylic pressure-sensitive adhesives which, when coated and dried as a film, resist water whitening." In contrast, the '172 application is directed to a dental adhesive for bonding with acrylic and metal materials. The reference does not disclose a pressure-sensitive adhesive (PSA), let alone a PSA that resists water-whitening. Accordingly, the '172 patent is non-analogous art, and the Examiner's second ground of rejection should, therefore, be withdrawn for this additional reason.

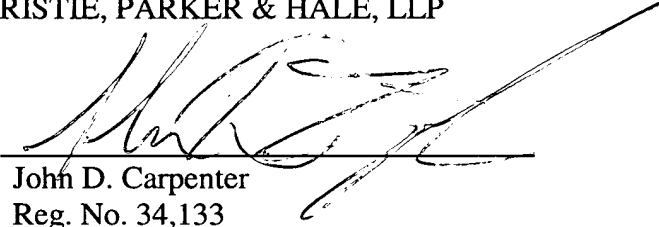
If, after considering the foregoing comments, the Examiner has any questions about the points discussed herein, she is invited to contact the undersigned at the number provided below.

In conclusion, Applicant submits that the present case is in condition for allowance. Reconsideration of the rejections and an early notice of allowance are respectfully requested.

Respectfully submitted,

CHRISTIE, PARKER & HALE, LLP

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